

Attorney Docket No.: DEX-0214
Inventors: Macina et al.
Serial No.: 09/909,567
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REMARKS

Claim 1 is pending in the instant application. Claim 1 has been rejected. Claim 1 has been amended. Support for these amendments is provided in the specification at page 19, lines 23-25, page 23, lines 3-19 and page 94, line 15, through page 96, line 30. No new matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claim 1 under 35 U.S.C. § 101

Claim 1 has been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended claim 1 to remove reference to variant sequences and to include the term "isolated" with respect to the claimed lung specific molecules in accordance with teachings at page 19, lines 23-25.

Withdrawal of this rejection is therefore respectfully requested.

II. Rejection of Claim 1 under 35 U.S.C. § 112, first paragraph

- Lack of Written Description

Claim 1 has been rejected under 35 U.S.C. § 112, first

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paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the invention was filed, had possession of the claimed invention.

The Examiner has acknowledged the specification to meet the written description requirements with respect to SEQ ID NO:12 and its full complement. However, the Examiner suggests that variant polynucleotides do not meet the written description requirements. Further, the Examiner suggests that claim 1 is directed to sequences that do not meet the written description requirements because of the wording "comprising" in lines 3 and 5 of claim 1.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended claim 1 to delete the term "comprising" in lines 3 and 5. Further, Applicants have deleted any reference to variant sequences. Instead, claim 1 has been amended to be drawn to an isolated lung specific molecule comprising a polynucleotide of SEQ ID NO:12; a polypeptide encoded by a polynucleotide of SEQ ID NO:12; or a polynucleotide with 97% identity to SEQ ID NO: 12 and which hybridizes under stringent conditions to the antisense sequence of SEQ ID NO: 12 and to clarify that the lung specific molecule is over-expressed in lung cancer. Support for this amendment is provided in the

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specification at page 23, lines 3-19 and page 94, line 15, through page 96, line 30. Methodologies to determine sequences with 97% identify which hybridize under stringent conditions to a defined sequence such as SEQ ID NO:12 are well known in the art. Further, methods for assessing over-expression of such polynucleotides in lung cancer can be performed based upon teachings in the specification beginning at page 92.

Applicants believe that these amendments, which are clearly supported by the specification, set forth definitive structural features of the claimed lung specific molecules so that one of skill in the art can predictably identify the encompassed molecules as being identical to those now claimed. Further, the claims as amended describe distinguishing identifying characteristics sufficient to show that applicant was in possession of the claimed invention. See MPEP § 2163.02. Thus, the claims as amended meet the written description requirements of 35 U.S.C. § 112, first paragraph.

Withdrawal of this rejection is therefore respectfully requested.

III. Rejection of Claim 1 under 35 U.S.C. § 112, second paragraph

Claim 1 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner suggests that recitation of the phrase "variant" is vague and indefinite.

Thus, while Applicants respectfully disagree given the definition for this term in the specification, in an earnest effort to advance the prosecution, Applicants have deleted this phrase from the claim.

Withdrawal of this rejection under 35 U.S.C. § 112, second paragraph is therefore respectfully requested.

IV. Rejection of Claim 1 under 35 U.S.C. § 102(b)

Claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Bandman et al.

Claim 1 has also been rejected under 35 U.S.C. § 102(b) as being anticipated by Yang et al. (WO 99/60160).

Applicants respectfully traverse this rejection.

The Examiner's suggestion that the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 is incorrect. Contrary to the Examiner's suggestion, SEQ ID NO:12 was taught in the provisional application as Figure 12, SEQ ID NO:12; Clone ID 19599. Thus, the effective filing date of the instant application with respect to claim 1 is July 21, 2000.

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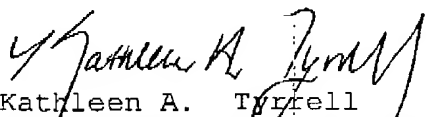
Further, as discussed in Sections II and III, Applicants have amended the claims to remove the term "variant", thus rendering moot the Examiner's comments regarding variant sequences taught by Bandman and Yang et al.

Withdrawal of these rejections under 35 U.S.C. § 102(b) is therefore respectfully requested.

V. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office communication of record. Accordingly, favorable Reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


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